

Patent Application No.: 10/172,148

REMARKS

This Amendment is submitted under MPEP 714.13 and adopts the Examiner's suggestion to specifically limit the scope of claim 1 to consist of only a single folding pulley. The Amendment to claim 1 places the claim in condition for allowance because it is now presented using a closed form transitional expression "consisting of". Dependant claims 3, 6, 12 and 13 have been amended so as to remain consistent with amended claim 1 (claim 12 lacked antecedent reference to the recited gears). Claim 5 has been canceled without prejudice.

The Office Action of Sept. 20, 2005 has been carefully considered. Applicants acknowledge the allowance of claims 17, 19 and 20. Reconsideration of this application, as proposed by amendment, is respectfully requested. The amendments proposed above present the rejected claims in condition for allowance, or at least in better form for consideration on appeal, having incorporated the Examiner's suggested revision to claim 1, and as such are requested by Applicants to be entered. As the nature of the amendment does not introduce new limitations not previously considered, or otherwise requiring a new search, Applicants respectfully seek entry thereof.

A. Final Rejection is Premature

Applicants hereby request reconsideration of the Office Action of September 20, 2005 as the finality of the rejection is urged to be premature. Applicants respectfully request withdrawal of the finality of the action. Support for withdrawal of the finality may be found within 37 CFR, which addresses the requirement to clearly designate the pertinence of each of the references or more specifically as stated in 37 CFR 1.104(c)(2), "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex, or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practical. The pertinence of each reference, if not apparent, must be explained and each rejection claim specified." Furthermore, pursuant to MPEP 706.07 (c) and (d), "[w]hen a claim is refused for any reason relating to the

Patent Application No.: 10/172,148

merits thereof it should be 'rejected' and the grounds of rejection fully and clearly stated," and the last paragraph further requires that, "[a] plurality of claims should never be grouped together in a common rejection, unless the rejection is equally applicable to all claims in the group." (emphasis added)

Applicants specifically note that for claims 21-25 (including independent claims 21 and 23) the Examiner's basis for the rejection has not been provided to the Applicants. Nor does the rejection particularly identify where the various limitations are taught within any of the references. Absent specific identification of the various elements recited in the claims, *prima facie* obviousness has not been established. Similarly, with respect to 2-3, 6, 8-9, and 11-16 "[t]he examiner has the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." (MPEP 2142) The Examiner is respectfully requested to provide Applicants with sufficient detail as to the teaching of the recited limitations of claims 2-3, 6, 8-9 and 11-16 so as to complete the proper examination, and permit Applicants' arguments in support of the patentably distinguishable aspects of each and every rejected claim. Absent specific basis for the rejections, Applicants respectfully request that the rejection of claims 2-3, 6, 8-9, 11-16, 21-25 be withdrawn and an indication of the allowance thereof be provided in a subsequent communication.

B. Rejection under 35 U.S.C. §103 over Weber et al. in view of the 3M Bulletin is Respectfully Traversed

Turning now to the substantive rejection, claims 1-3, 5, 6, 8, 9, 11-16 and claims 21-25 were rejected under USC 103(a) as unpatentable over Weber, et al. (US 5,725,140) in view of the 3M Technical Bulletin.

The Examiner has indicated that claim 1 would be allowable if expressed in a closed-ended transitional format such as "consisting of." In view of the proposed amendment to claim 1, the rejection under 35 U.S.C. §103 over Weber, et al, in view of the 3M Technical Bulletin is respectfully traversed.

Patent Application No.: 10/172,148

In formulating the rejection under 35 U.S.C. §103, the Examiner alleges that Weber teaches a cam following lever type reciprocating component feeder having a ratchet driven roller for intermittently advancing the tape in a manner claimed by the applicant so as to pull the cover tape past a peel blade in order to separate the cover tape from the pocket tape, thereby exposing the component therein without the use of a drive motor. Notably, Weber fails to make any reference or suggestion for the use of a drive motor, control unit, single folding pulley or reservoir fullness gauge as claimed by the Applicant. The Examiner however recognizes that Weber fails to teach a folding pulley, and to meet this deficiency the Examiner alleges that the 3M Technical Bulletin teaches such a concept.

The 3M Bulletin discusses an improvement to cover tape handling whereby two or three folding rollers, in conjunction with a tensioning roller, fold the cover tape onto itself in order to capture the pressure sensitive adhesive there within. From these teachings, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Weber with the teachings of the 3M Bulletin to provide a motor driven, single folding pulley component tape feeder having a reservoir fullness gauge.

The Examiner further alleges that the drive and control system for monitoring reservoir capacity as claimed by the Applicant are well known in the art. Notably, as required by 37 CFR 1.104(d)(2), no such teaching has been set forth for the recited element, let alone a teaching of a controller or similar unit as set forth in specific detail in dependent claims 3 and 6. Accordingly, the conclusion by the Examiner, and ensuing rejection of claim 1, is respectfully traversed.

While the 3M Bulletin discloses a multi-pulley cover tape folding system, such a teaching is not a disclosure of the single pulley system as now recited in amended independent claim 1. Moreover, in light of the Examiner's recommendation, claim 1 has been amended to specifically recite a feeder consisting of only a single folding pulley, and is now believed to be patentably

Patent Application No.: 10/172,148

distinguishable over the two and/or three folding roller disclosure of 3M. Claim 1 has been amended to further consist of a control unit as originally found as a limitation in dependent claim 3. Additionally, claims 3 and 6 have been amended to further characterize the control unit now initially recited within claim 1. Applicants note that the amendment to claim 1 does not add any new matter not previously considered as it merely recites an element previously incorporated in claims 3 and 6.

As for claims 3, 6, and 21-25, these claims recite elements for monitoring the advanced cover tape so as to gauge the remaining capacity of the reservoir. With respect to claims 21 and 23, Applicants acknowledge that Weber discloses a mechanical feeder, however the present invention is reliant on a electromechanical feeder having a control unit to facilitate the measuring of the remaining capacity of the reservoir as recited in these independent claims.

Neither Weber nor the 3M Bulletin make reference to a control unit, and both further lack an electromechanical means to advance the cover tape and to monitor the fullness or capacity of the reservoir (tape length or force required to drive the cover tape into the reservoir, respectively). In view of the failure of the cited references to disclose such limitations, claims 3, 6 and 21-25 are urged to be patentably distinguishable over the combination of Weber in view of the 3M Bulletin.

Claims 8, 9 and 11 also recite limitations not found in Weber or the 3M Bulletin. Each claim recites limitations relative to the structure of the cover tape reservoir introduced in claim 1, such as the interior surface of the reservoir found (claim 8 – 9) and/or the shape of the perimeter (claim 11). As the specific limitations of claims 8, 9 and 11 are not taught or suggested by the references as set forth, either independently or in combination, Applicants respectfully submit that no *prima facie* obviousness has been established and request that the Examiner withdraw the rejection of claims 8, 9 and 11 and indicate the allowance thereof.

Patent Application No.: 10/172,148

Referring now to the rejected claims 13 – 16, the claims set forth a further limitation of a splice deflector. Neither Weber nor the 3M Bulletin recognize the problems encountered while folding over the edges of a cover tape that has been previously spliced to yet another cover tape. As disclosed in the specification (e.g., pg. 10, line 10) a splice has a tendency to peel away from the cover tape as it is pulled over the radius of the single folding pulley. Accordingly the claimed limitation of a splice deflector maintains the attachment of the splice as the cover tape bends into the folding pulley. Applicants submit that absent a teaching of the problem to which the splice deflector is directed, both Weber and 3M Bulletin cannot disclose a solution. Accordingly, claims 13 – 16 are believed to be patentably distinguishable over the cited references, and are believed to overcome the rejection.

With respect to claims 21 - 25, the Examiner has rejected each claim as being unpatentable over Weber et al, in view of the 3M Bulletin. In establishing *prima facie* obviousness, the limitations within the claim must be taught or suggested within the cited references. Applicants incorporate herein the traversal of claims 21 - 25 above, and further note that Weber provides no suggestion or disclosure for monitoring of cover tape volume within a reservoir. As previously noted, in view of the absence of any drive motors or associated control circuits, Weber lacks any capability for measuring and/or monitoring the remaining capacity of the reservoir, as disclosed in the present invention. Taking into consideration the combination of Weber, in view of the 3M Bulletin, at best such a combination would teach using two or three rollers to fold over the edges of a cover tape within a mechanical tape feeder. Applicants further argue that the reliance of the present invention on at least one motor and associated electronics to support the folding and monitoring of cover tape are not taught in the relied upon references, and the suggested combination fails to suggest the intended functions of the claimed invention. Applicants also respectfully note that the Examiner has once more neglected to provide any references that would teach or suggest monitoring of cover tape in a reservoir, as specified in rejected claims 21 - 25. Accordingly, Applicants further request these claims be indicated as allowable, or that

Patent Application No.: 10/172,148

Applicants be given an opportunity to traverse should a complete basis be set forth for the rejection of claims 21 – 25.

In summary both Weber and the 3M Bulletin, singly or in combination, fail to teach or suggest the use of a control unit to facilitate the advancing of a component carrier tape, or the use of a single folding pulling and monitoring the volume of the cover tape fed within a tape feeder.

In view of all the reasons set forth above, the Examiner is respectfully requested to enter the proposed amendment and indicate the allowance of the remaining claims, or to withdraw the Final Action and provide Applicants with a detailed rejection to which a response or further amendments as of right can be directed.

In the event the Examiner consider personal contact advantageous to the timely disposition of this case, they are hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



Duane C. Basch
Attorney for Applicant
Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526

(585) 899-3970

DCB/arr